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09/210,472

12/14/1998

GYU-YEONG SON

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12/17/2003

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EXAMINER

TRAN, THAI Q

ART UNIT

PAPER NUMBER

2615

26

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/210,472

Applicant(s)

SON ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed Sept. 30, 2003 have been fully considered but they are not persuasive.

In re pages 1-2, applicants submit that the invention disclosure record discloses a date of conception on or before September 26, 1997 which predates the U.S. filing date of Cato, and the date of filing of the corresponding Korean Patent Application 1997-68542 upon which priority has been claimed establishes a reduction to practice on December 13, 1997. Thus, Cato no longer qualifies as prior art under 35 U.S.C. §102(e) since the invention was not "described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent." MPEP 2136.05, MPEP 715.

In response, the Examiner respectfully disagrees. MPEP §715.07(a) states

"Where conception occurs prior ...

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference and ends with the date of the reduction to practice, **either actual or constructive (i.e., filing a United State patent application)**. Note, therefore, that only diligence before reduction to practice is a material ...

Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking."

From MPEP, the constructive reduction to practice is a filing data of United State patent application. The declaration under 37 CFR 1.131 **is insufficient** to establish diligence from a date prior to the date of reduction to practice of the Cato reference to either a **constructive reduction to practice**, which is a filing date of the United State patent application, or an actual reduction to practice because the declaration under 37

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CFR 1.131 shows diligence from a date prior to the date of reduction to practice of the Cato reference to the date of filing of the corresponding **Korean Patent Application 1997-68542** but not the filing date of the United State patent application.

In re page 2, applicants argue that, since Cato is no longer prior art as discussed above and since the Examiner cites no other prior art as anticipating claims 16-85, claims 16-85 are deemed patentable.

In response, as discussed above, the declaration under 37 CFR 1.131 is **insufficient** to establish diligence and; therefore, Cato still qualifies as prior art under 35 U.S.C. §(e).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-35 and 37-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Cato ('111 B1) as set forth in paragraph #3 of the last Office Action.

Regarding claim 16, Cato discloses a method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast (Fig. 3), the method comprising:

receiving program guide information associated with the upcoming program (col. 7, line 63 to col. 8, line 15);

receiving, during the broadcast of the program review, a user command to reserve the upcoming program for future recording (col. 10, lines 54-66); and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information (col. 10, lines 1-32),

wherein said reserving the upcoming program is only operable while the program preview is being displayed (col. 10, lines 54-67).

Regarding claim 17, Cato discloses the claimed wherein the program guide information is embedded in the program preview (col. 7, lines 33-61).

Regarding claim 18, Cato discloses the claimed wherein the program preview comprises audio and video data in addition to the program guide information (col. 9, lines 26-33).

Regarding claim 19, Cato discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (col. 7, line 63 to col. 8, line 15).

Regarding claim 20, Cato discloses the claimed wherein said reserving the upcoming program comprises reserving the upcoming program without retrieving stored program guide information from a memory (col. 11, line 49 to col. 12, line 15).

Regarding claim 21, Cato discloses the claimed prompting a user for the user command to reserve the upcoming program for future recording during the broadcast of the program preview (col. 11, line 49 to col. 12, line 15).

Regarding claim 22, Cato discloses the claimed providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (col. 11, line 49 to col. 12, line 15).

Regarding claim 23, Cato discloses the claimed wherein the user command is generated in response to a single action of a user (col. 11, line 49 to col. 12, line 15).

Regarding claim 24, Cato discloses a program recording device (Fig. 3) for reserved recording of an upcoming program while a program preview or the upcoming program is being broadcast, the device comprising:

- a memory (internal memory 332, col. 10, lines 1-21) to store program guide information associated with the upcoming program;

- a user interface (col. 11, line 49 to col. 12, line 15) to receive, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording; and

- a controller (CPU 312, col. 11, lines 39-48) to reserve the upcoming program for future recording using the program guide information,

- wherein the program guide information is not stored in said memory unit the user command is received (col. 4, lines 60-65 and col. 10, lines 1-20 and 54-67), and

the controller is not operable to reserve the upcoming program unless the user command is receiving during the broadcast of the program information (col. 7, lines 46-62 and col. 11, line 49 to col. 12, line 15).

Regarding claim 25, Cato discloses the claimed a receiver to receive the program guide information (receiver 104, col. 7, line 63 to col. 8, line 15).

Regarding claim 26, Cato discloses the claimed wherein the program guide information is embedded in the program preview (col. 7, lines 33-61).

Regarding claim 27, Cato discloses the claimed wherein the program preview comprises audio and video data in addition to the program guide information (col. 9, lines 26-33).

Regarding claim 28, Cato discloses the claimed wherein the program guide information for the upcoming program to be broadcast at the future time is automatically received without another user command requesting the program guide information (col. 7, line 63 to col. 8, line 15).

Regarding claim 29, Cato discloses the claimed wherein the program guide information is not stored as it is received by said receiver unless in response to the user command to reserve the upcoming program for future recording (col. 4, lines 60-65 and col. 10, lines 1-20 and 54-67).

Regarding claim 30, Cato discloses the claimed wherein said controller further prompts a user for the user command during the broadcast of the program preview (col. 11, line 49 to col. 12, line 15).

Regarding claim 31, Cato discloses the claimed a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (col. 11, line 49 to col. 12, line 15).

Regarding claim 32, Cato discloses the claimed wherein the user command is generated in response to a single action of a user (col. 11, line 49 to col. 12, line 15).

Regarding claim 33, Cato discloses the claimed a recording unit (video cassette recorder, col. 11, line 49 to col. 12, line 15) that is operable to record the upcoming program in accordance with the program guide information stored in said memory.

Regarding claim 34, Cato discloses the claimed wherein said recording unit comprises a video cassette recorder (col. 11, line 49 to col. 12, line 15).

Regarding claim 35, Cato discloses the claimed wherein said recording unit comprises a television having a recording unit (col. 11, line 49 to col. 12, line 15).

The computer readable storage medium claims 37 is met by the internal memory 332 disclosed in col. 6, lines 54-67 and reasons as discussed in claim 16 above.

Claim 38 is rejected for the same reasons as discussed in claim 17 above.

Claim 39 is rejected for the same reasons as discussed in claim 21 above.

Claim 40 is rejected for the same reasons as discussed in claim 22 above.

Claim 41 is rejected for the same reasons as discussed in claim 18 above.

Claim 42 is rejected for the same reasons as discussed in claim 19 above.

Claim 43 is rejected for the same reasons as discussed in claim 20 above.

Claim 44 is rejected for the same reasons as discussed in claim 23 above.

Regarding claim 45, Cato discloses the claimed recording the upcoming program in accordance with the program guide information (col. 11, line 49 to col. 12, line 15).

Regarding claim 46, Cato discloses a method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast (Fig. 3), the method comprising:

receiving the program preview including program guide information associated with the upcoming program (col. 7, line 63 to col. 8, line 15);

displaying the program preview (col. 7, lines 23-32);

receiving, during said displaying the program preview, a user command to reserve the upcoming program for future recording while the program guide information is being received (col. 11, line 49 to col. 12, line 15); and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information without the program guide information being displayed (col. 11, line 49 to col. 12, line 15).

Regarding claim 47, Cato discloses the claimed receiving a plurality of program previews for a plurality of upcoming programs (col. 7, line 63 to col. 8, line 15); and storing the plurality of program previews (col. 7, line 63 to col. 8, line 15); wherein said displaying the program previews comprises sequentially replaying the stored plurality of program previews (col. 7, line 63 to col. 8, line 15).

Claim 48 is rejected for the same reasons as discussed in claim 22 above.

Claim 49 is rejected for the same reasons as discussed in claim 23 above.

Regarding claim 50, Cato discloses a method of reserved recording of an upcoming program while a program preview for the upcoming program being broadcast (Fig. 3), the method comprising:

receiving program guide information associated with the upcoming program (col. 7, line 63 to col. 8, line 15);

using a user input interface having user selection keys to generate a user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to selected and reserve the upcoming program (col. 11, line 49 to col. 12, line 15); and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information (col. 11, line 49 to col. 12, line 15).

Regarding claim 51, Cato discloses the claimed wherein the user command is generated in response to the single action of a user while the program guide information is not displayed (col. 11, line 49 to col. 12, line 15).

The computer readable storage medium claims 52 is met by the internal memory 332 disclosed in col. 6, lines 54-67 and reasons as discussed in claim 50 above.

Claim 53 is rejected for the same reasons as discussed in claim 51 above.

Claim 54 is rejected for the same reasons as discussed in claim 17 above.

Claim 55 is rejected for the same reasons as discussed in claim 18 above.

Claim 56 is rejected for the same reasons as discussed in claim 19 above.

Claim 57 is rejected for the same reasons as discussed in claim 20 above.

Claim 58 is rejected for the same reasons as discussed in claim 21 above.

Claim 59 is rejected for the same reasons as discussed in claim 22 above.

Claim 60 is rejected for the same reasons as discussed in claim 23 above.

Claim 61 is rejected for the same reasons as discussed in claim 25 above.

Claim 62 is rejected for the same reasons as discussed in claims 17 and 26 above.

Claim 63 is rejected for the same reasons as discussed in claims 18 and 27 above.

Claim 64 is rejected for the same reasons as discussed in claim 28 above.

Regarding claim 65, Cato discloses the claimed wherein the program guide information is not displayed as it is received by said receiver while the user command to reserve the upcoming program for future recording is received (col. 11, line 49 to col. 12, line 15).

Claim 66 is rejected for the same reasons as discussed in claim 30 above.

Claim 67 is rejected for the same reasons as discussed in claims 22 and 31 above.

Claim 68 is rejected for the same reasons as discussed in claims 23 and 32 above.

Claim 69 is rejected for the same reasons as discussed in claim 33 above.

Claim 70 is rejected for the same reasons as discussed in claim 17 above.

Claim 71 is rejected for the same reasons as discussed in claims 21 and 39 above.

Claim 72 is rejected for the same reasons as discussed in claims 22 and 40 above.

Claim 73 is rejected for the same reasons as discussed in claims 18 and 41 above.

Claim 74 is rejected for the same reasons as discussed in claims 19 and 42 above.

Claim 75 is rejected for the same reasons as discussed in claims 20 and 43 above.

Claim 76 is rejected for the same reasons as discussed in claims 21 and 44 above.

Claim 77 is rejected for the same reasons as discussed in claim 45 above.

Regarding claim 78, Cato discloses the claimed wherein the received program guide information is not stored unless the user command is received (col. 4, lines 60-65 and col. 10, lines 1-20 and 54-67).

Claim 79 is rejected for the same reasons as discussed in claim 78 above.

Claim 80 is rejected for the same reasons as discussed in claim 78 above.

Regarding claim 81, Cato discloses a method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast (Fig. 3), the method comprising:

receiving program guide information associated with the upcoming program, the program guide information being included with the program preview (col. 7, line 63 to col. 8, line 15 and col. 7, lines 33-61);

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receiving, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording (col. 11, line 49 to col. 12, line 15); and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information (col. 11, line 49 to col. 12, line 15);

wherein said reserving the upcoming program is only operable while the program preview is being broadcast (col. 11, line 49 to col. 12, line 15).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cato ('111 B1) as set forth in paragraph #5 of the last Office Action.

Cato discloses all the features of the instant invention as discussed in claim 33 above except for providing wherein said recording unit comprises a Hard Disc drive.

The capability of recording/reproducing video signal using Hard Disc drive is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known Hard Disc drive into Cato's system in order to decrease the time in searching for the desired video signal because Hard Disc drive has random access capability.

6. Claims 82-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cato ('111 B1) in view of Mankovitz ('719 B2) as set forth in paragraph #6 of the last Office Action.

Regarding claim 82, Cato discloses all the features of the instant invention as discussed in claim 16 above except for providing, if the user command is not received during the broadcast of the program preview: receiving another user command to display program information not received during the broadcast of the program preview; and reserving the upcoming program using the displayed program information.

Mankovitz teaches a television program record scheduling and satellite receiver control using compressed codes having G-code switch 22 allowing the user to display program information not received during the broadcast of the program preview and

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reserving the upcoming program using the displayed program information (col. 1, line 66 to col. 5, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the G-code decoder as taught by Mankovitz into Cato's system in order to simplify the process of programming the VCR for unattended recording.

Regarding claim 83, Mankovitz also discloses the claimed receiving another user command to display program information not received during the broadcast of the program preview (G-code switch 22 disclosed from col. 1, line 66 to col. 5, line 67); and alternately reserving the upcoming program using the displayed program information (reserving the upcoming program using G-code disclosed from col. 1, line 66 to col. 5, line 67).

Claim 84 is rejected for the same reasons as discussed in claim 83 above.

Claim 85 is rejected for the same reasons as discussed in claim 83 above.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

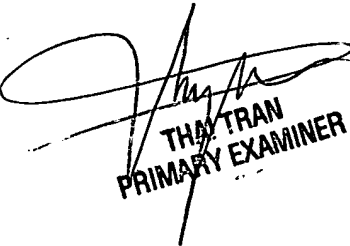
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ



THAI TRAN
PRIMARY EXAMINER